REMARKS

Claims 1-6, 8-11, and 13-20 are pending in the present case. Claims 1-2, 5-6, 8-11, and 13-20 are amended herein. Claims 7 and 12 are cancelled herein. Applicant respectfully requests reconsideration in view of the above amendments to the present application, and the arguments set forth below. No new matter is added herein.

REJECTIONS OF THE CLAIMS

Claims 1-20 are rejected under 35 USC 103(a) over US Patent No. 6,073,133 to Chrabaszcz (hereinafter Chrabaszcz) in view of US Patent No. 5,850,156 to Meister, et al. (hereinafter Meister). Applicant has reviewed the references cited and respectfully asserts that they do not suggest the embodiments of the present invention as recited in Claims 1-6, 8-11, and 13-20 for the following rationale.

As Applicant understands the reference, Chrabaszcz teaches an email attachment verifier. However, Applicants find no teaching or suggestion within Chrabaszcz directed towards automatically updating a keyword database and an addressee database, provided that an attachment is sent with a message, as claimed in embodiments of the present invention. Therefore, the email attachment verifier taught by Chrabaszcz differs from embodiments of the present invention recited in Clams 1-6, 8-11, and 13-20.

As amended herein, independent Claim 1 reads as follows, with underlining added herein for emphasis:

      1.   A method of sending an electronic message comprising:

     a) examining syntactic content of said electronic message;

     b) comparing said syntactic content to a first database for a first match;

     c) examining said addressed destination of said message to determine an identity of an intended addressee;

     d) comparing said identity of said intended ` addressee to a second database for a second match;

     e) alerting said sender that said electronic message does not have an attachment, based on said first match and said second match: and

     f) <u>automatically updating said first and said second databases, provided that said attachment is attached to said message</u>.

As amended herein, Claim 1 recites that, where an attachment is sent with an electronic message, e.g., originally, in response to e), etc., the first and the second databases are automatically updated. Independent Claims 14 and 18 respectively recite updating of databases similar to the first and the second database recited in Claim 1.

Automatically updating the first and second databases as claimed allows a self-learning modality to operate with the claimed embodiments. This conveniently allows the frequencies with which certain key words and/or addressee addresses correlate to sending attachments with messages, to be tracked and kept accurate and up-to-date (e.g., as for subsequent or future use with correct predictive attachment prompting operation). Advantageously, this deters unnecessary further attachment prompts for words and/or addressees no longer requiring such prompting. This has the further benefit of reducing user inconvenience and annoyance. Chrabaszez fails to teach or suggest automatically updating such databases, as claimed.

In fact, Chrabaszez teaches that a "[u]ser may modify, add and delete keywords/phrases, based on an initial configuration provided with the attachment verifier at the time of its installation." Chrabaszez, Col. 4, ll. 47-50, underlining added for emphasis. Thus, while Chrabaszez's database of key words/phrases may be modified, a user must take a positive manual action to do so. Applicant respectfully asserts that, in expressly so teaching, Chrabaszez effectively teaches away from the embodiments recited in Claims 1 and 14, wherein such a database is automatically updated upon sending a message that has an attachment.

As Applicants understand the reference, Meister's teachings are "directed to a system that alerts or warns a user of an electronic mail system as to the addressees of a message before the message is sent, after the user indicates that the message is to be sent, and allows the sender to revise the list of addressees or cancel the sending entirely." Meister, Col. 1, ll. 11-15. However, Applicants find no teaching or suggestion therein directed towards any database of key words and phrases (e.g., such as the first database recited in Claim 1 herein). Applicants also find no teaching or suggestion in Meister directed towards automatically updating its addressee database (e.g., such as the second database recited in Claim 1 herein).

Meister expressly teaches that its objects include:

(1) "to provide an e-mail system that alerts a user to the addressees of an e-mail message before it is sent";

(2) "to alert a user when an unauthorized e-mail message is being sent";

(3) "to allow a user to modify a list of addressees of an email message before the message is sent and after the addressee list is originally created"; and

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(4) "to determine whether an addressee's address is properly entered and to alert the user in the case of potentially undeliverable message prior to sending." Id. at Col. 2, II. 7-19, underlining added for emphasis. Meister goes on to teach that "[t]he sender can then verify that the addresses are correct or change or delete those on the list," and "allows the user to delete [an] unauthorized message." Id. at II. 23-26.

Thus, Meister's teachings are expressly "directed to" (Id. at Col. 1, I. 9) alerting a user about the correctness of addressees' addresses in email messages and to a user taking a positive action to correct same, where an address is incorrect. While Meister teaches some automatic action, such action therein is expressly limited to comparing addresses, as typed, with listed addresses. Applicants respectfully assert that, in expressly limiting automatic action therein to address checking, Meister effectively teaches away from the embodiments recited in Claims 1, 14 and 18, which relate to attachment confirmation.

Moreover, where a system such as taught by Meister does alert a user to an incorrect address, the address alerted to therein is in the message address field and a positive manual user action is required to correct it. Applicants thus also respectfully assert that, in teaching correction of the address in the message address field, Meister teaches away from the embodiments recited in Claims 1, 14, and 18, relating to updating an address database, and that in requiring positive manual user action to change the address, Meister further teaches away from these embodiments, which are automatic. Chrabaszez does not cure these defects of Meister. Meister does not cure the defects of Chrabaszez, discussed above.

Applicants respectfully point out that, obviousness can only be established by combining or modifying the teachings of the references cited to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Here, Applicants have reviewed both the Chrabaszez and Meister references and yet find no teaching, suggestion, or motivation to modify the teachings therein to achieve verification of attachment for an electronic message with automatic updating of key word and address databases, as claimed. Further, as discussed above, both references expressly teach away from such embodiments. Thus, Applicants respectfully assert that Claims 1-6, 8-11, and 13-20 are allowable over Chrabaszez in view of Meister under 35 USC 103(a).

CONCLUSION

By the rationale stated above, Applicants respectfully assert that Claims 1-6, 8-11, and 13-20 are allowable under 35 USC 103(a). Accordingly, Applicants respectfully request that the rejection of these claims under this statute be withdrawn and that Claims 1-6, 8-11, and 13-20 be timely allowed.

Please charge our deposit account No. 23-0085, for any unpaid fees.

Respectfully submitted,

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